

Image



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sean A. McCarthy
Application No.: 09/263,022 Group: 1647
Filed: March 5, 1999 Examiner: D.S. Romeo
Confirmation No.: 1313
For: NOVEL HUMAN DICKKOPF-RELATED PROTEIN AND
NUCLEIC ACID MOLECULES AND USES THEREFOR

CERTIFICATE OF MAILING OR TRANSMISSION

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as First Class Mail in an envelope addressed to Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450, or is being facsimile transmitted to the United States Patent and Trademark Office on:

04-06-04 Sandra J. Jinnal
Date Signature

Sandra Jinnal
Typed or printed name of person signing certificate

REQUEST FOR CORRECTED FILING RECEIPT
FOR UTILITY APPLICATION

Office of Initial Patent Examination
Customer Service Center
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

We hereby request that the following items of information be corrected in the Filing Receipt for the subject application received on April 23, 2001.

The errors and corrections are noted on the enclosed copy of the Filing Receipt (changes noted in red). As corrected, the Domestic Priority data should read as shown below:

In the Domestic Priority data as claimed by applicant:

**THIS APPLICATION IS A CIP OF PCT/US98/07894 04/16/98
WHICH IS A CIP OF 09/009,802 01/20/1998
WHICH CLAIMS BENEFIT OF 60/071,589 01/15/1998
AND WHICH IS A CIP OF 08/842,898 04/17/1997 ABN
WHICH IS A CIP OF 08/843,704 04/16/1997 ABN**

Also enclosed are copies of (a) a Petition Under 37 C.F.R. § 1.182 or § 1.183 Requesting Entry of Amendment; (b) Amendment (directing amendment of the Related Applications paragraph); and (c) a Decision on Petition (granting the Petition and request for entry of the Amendment).

Pursuant to instructions in the February 29, 2000 O.G., we hereby request that the errors which are identified above be corrected in the captioned application to which this request for correction is directed. It is understood that the Patent Office will issue an automatically-generated, corrected Filing Receipt in this and, if applicable, any other affected applications.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By *Helen E. Wendler*

Helen E. Wendler

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Telephone: (978) 341-0036

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Concord, MA 01742-9133

Date: *April 6, 2004*



UNITED STATES PATENT AND TRADEMARK OFFICE

COMMISSIONER FOR PATENTS
UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, D.C. 20231
www.uspto.gov

APPLICATION NUMBER	FILING DATE	GRP ART UNIT	FIL FEE REC'D	ATTY. DOCKET NO	DRAWINGS	TOT CLAIMS	IND CLAIMS
09/263,022	02/26/2000	1633	926	MNI-108CP2	15	22	2

000959
LAHIVE & COCKFIELD
28 STATE STREET
BOSTON, MA 02109

CONFIRMATION NO. 1313

UPDATED FILING RECEIPT



OC00000005987379

Date Mailed: 04/19/2001

Receipt is acknowledged of this nonprovisional Patent Application. It will be considered in its order and you will be notified as to the results of the examination. Be sure to provide the U.S. APPLICATION NUMBER, FILING DATE, NAME OF APPLICANT, and TITLE OF INVENTION when inquiring about this application. Fees transmitted by check or draft are subject to collection. Please verify the accuracy of the data presented on this receipt. **If an error is noted on this Filing Receipt, please write to the Office of Initial Patent Examination's Customer Service Center. Please provide a copy of this Filing Receipt with the changes noted thereon. If you received a "Notice to File Missing Parts" for this application, please submit any corrections to this Filing Receipt with your reply to the Notice. When the PTO processes the reply to the Notice, the PTO will generate another Filing Receipt incorporating the requested corrections (if appropriate).**

Applicant(s)

SEAN MCCARTHY, SAN DIEGO, CA;

Domestic Priority data as claimed by applicant

THIS APPLICATION IS A ^{CIP} ~~CON~~ OF PCT/US98/07894 04/16/1998

which is a CIP

~~AND A CON~~ OF 09/009,802 01/20/1998

which

~~AND CLAIMS BENEFIT~~ OF 60/071,589 01/15/1998

and which is a CIP

~~AND A CON~~ OF 08/842,898 04/17/1997 ABN

which is a CIP

~~AND A CON~~ OF 08/843,704 04/16/1997 ABN

Foreign Applications

If Required, Foreign Filing License Granted 03/31/1999

Projected Publication Date: N/A

Non-Publication Request: No

Early Publication Request: No

Title

<p>RECEIVED LAHIVE & COCKFIELD DCPT DEPT. ENTERED APR 23 2001</p> <p>RETRIEVED: _____ FORWARDED: _____</p> <p><i>4/26</i> <i>5/2</i> <i>3/12</i></p>

NOVEL HUMAN DICKKOPF-RELATED PROTEIN AND NUCLEIC ACID MOLECULES AND
USES THEREFOR

Preliminary Class

424

Data entry by : GUNTER RILEY, JOYCE

Team : OIPE

Date: 04/19/2001





**LICENSE FOR FOREIGN FILING UNDER
Title 35, United States Code, Section 184
Title 37, Code of Federal Regulations, 5.11 & 5.15**

GRANTED

The applicant has been granted a license under 35 U.S.C. 184, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" followed by a date appears on this form. Such licenses are issued in all applications where the conditions for issuance of a license have been met, regardless of whether or not a license may be required as set forth in 37 CFR 5.15. The scope and limitations of this license are set forth in 37 CFR 5.15(a) unless an earlier license has been issued under 37 CFR 5.15(b). The license is subject to revocation upon written notification. The date indicated is the effective date of the license, unless an earlier license of similar scope has been granted under 37 CFR 5.13 or 5.14.

This license is to be retained by the licensee and may be used at any time on or after the effective date thereof unless it is revoked. This license is automatically transferred to any related applications(s) filed under 36 CFR 1.53(d). This license is not retroactive.

The grant of a license does not in any way lessen the responsibility of a licensee for the security of the subject matter as imposed by any Government contract or the provisions of existing laws relating to espionage and the national security or the export of technical data. Licensees should apprise themselves of current regulations especially with respect to certain countries, of other agencies, particularly the Office of Defense Trade Controls, Department of State (with respect to Arms, Munitions and Implements of War (22 CFR 121-128)); the Office of Export Administration, Department of Commerce (15 CFR 370.10 (j)); the Office of Foreign Assets Control, Department of Treasury (31 CFR Parts 500+) and the Department of Energy.

NOT GRANTED

No license under 35 U.S.C. 184 has been granted at this time, if the phrase "IF REQUIRED, FOREIGN FILING LICENSE GRANTED" DOES NOT appear on this form. Applicant may still petition for a license under 37 CFR 5.12, if a license is desired before the expiration of 6 months from the filing date of the application. If 6 months has lapsed from the filing date of this application and the licensee has not received any indication of a secrecy order under 35 U.S.C. 181, the licensee may foreign file the application pursuant to 37 CFR 5.15 (b).

PLEASE NOTE the following information about the Filing Receipt:

- o The articles such as "a," "an" and "the" are not included as the first words in the title of an application. They are considered to be unnecessary to the understanding of the title.
- o The words "new," "improved," "improvements in" or "relating to" are not included as first words in the title of an application because a patent application, by nature, is a new idea or improvement.
- o The title may be truncated if it consists of more than 600 characters (letters and spaces combined).
- o The docket number allows a maximum of 25 characters.
- o If your application was submitted under 37 CFR 1.10, your filing date should be the "date in" found on the Express Mail label. If there is a discrepancy, you should submit a request for a corrected Filing Receipt along with a copy of the Express Mail label showing the "date in."
- o The title is recorded in sentence case.

Any corrections that may need to be done to your Filing Receipt should be directed to:

Assistant Commissioner for Patents
Office of Initial Patent Examination
Customer Service Center
Washington, DC 20231



COPY

Paper No. 16

LAHIVE & COCKFIELD, LLP.
28 STATE STREET
BOSTON MA 02109

COPY MAILED

MAR 12 2004

OFFICE OF PETITIONS

ON PETITION

In re Application of :
Sean A. McCarthy :
Application No. 09/263,022 :
Filed: 5 March, 1999 :
Attorney Docket MNI-108CP2 :

This is a decision on the petition under 37 CFR 1.182, filed on 27 February, 2004, requesting entry of an amendment to the specification to insert a reference to an earlier-filed application pursuant to the provisions of 35 U.S.C. § 120.

The petition is GRANTED.

The record indicates that this application was co-pending with earlier-filed international application No. PCT/US98/07894, filed on 16 April, 1998, which was copending with application No. 09/009,802, filed on 20 January, 1988, which was copending with application No. 60/071,589, which was filed on 15 January, 1998, and application No. 09/009,802 was copending with application No. 08/842,898, filed on 17 April, 1997, which was copending with application No. 08/843,704, filed on 16 April, 1997. Petitioner requests that this abandoned application be amended by inserting a reference to the earlier-filed application.

35 U.S.C. § 120 permits entry of a subsequent amendment to an abandoned application in applications filed prior to 29 November, 2000, to include the benefit of an earlier filing date for purposes other than prosecution.¹

In view thereof, the request for entry of an amendment to insert a reference to the above-noted earlier-filed applications is granted.

¹See Sampson v. Commissioner of Patents and Trademarks, 1976).

WAF-0108CP2
RECEIVED
LAHIVE & COCKFIELD
DOCKET DEPT.
195 USPQ 136 (D.C.D.C.)
MAR 16 2004
RETRIEVED:
FORWARDED: dg

Application No. 09/263,022

2

The application file is being forwarded to Technology Center 1600 for entry of the amendment.

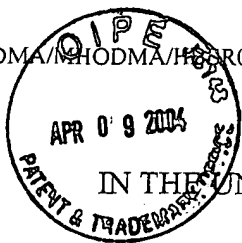
Telephone inquiries concerning this matter may be directed to the undersigned at (703)308-6918.



Douglas I. Wood
Senior Petitions Attorney
Office of Petitions

COPY
Attorney's Docket No.: MNI-108CP2 (1855.2067-002)

PATENT APPLICATION
Attorney's Docket No.: MNI-108CP2 (1855.2067-002)



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sean A. McCarthy
Application No.: 09/263,022 (ABANDONED) Group: 1647
Filed: March 5, 1999 Examiner: David S. Romeo
Confirmation No.: 1313
For: NOVEL HUMAN DICKKOPF-RELATED PROTEIN AND NUCLEIC ACID
MOLECULES AND USES THEREFOR

EL 955641153US

Date: <u>February 27, 2004</u>
EXPRESS MAIL LABEL NO. <u>EL 955641153 US</u>

PETITION UNDER 37 C.F.R. § 1.182 OR § 1.183
REQUESTING ENTRY OF AMENDMENT

VIA EXPRESS MAIL LABEL NO. EL 955641153 US

Mail Stop PETITION
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This Petition is being filed to request entry of an amendment to the specification of the subject patent application. The undersigned recognizes that the application is currently abandoned. However, amendment of the application is necessary to perfect the priority claim under 35 U.S.C. § 120, and preserve the right to claim priority through the subject application in a subsequent pending continuation application (Application No. 09/972,473, filed October 4, 2001).

The subject application, now abandoned, was filed by Applicant's prior counsel under 35 U.S.C. § 111 and 37 C.F.R. § 1.53(b) on March 5, 1999 with a transmittal letter stating:

Transmitted herewith for filing is the Continuation-in-Part of **PCT/US98/07894**, filed **April 16, 1998**, which in turn claims the benefit of prior-filed application **U.S. Patent Application Serial No. 09/009,802**, filed **January 20, 1998**. U.S. Patent Application Serial No. 09/009,802 claims the benefit of prior-filed **U.S. Provisional Patent Application Serial No. 60/071,589**, filed **January 15, 1998** and of prior-filed **U.S. Patent Application Serial No. 08/842,898**, filed **April 17, 1997**. U.S. Patent Application Serial No. 08/842,898 is a continuation-in-part of **U.S. Patent Application No. 08/843,704**, filed **April 16, 1997**.

(Transmittal Letter at 1.)

The specification as filed contained a "Cross-Reference to Related Applications" paragraph immediately following the title, that contained reference to each of the priority applications. However, the reference to the priority applications did not specify the relationships of the applications, with the exception of U.S. Patent Application Serial No. 08/842,898 being a continuation-in-part of U.S. Patent Application No. 08/843,704, as required by former 37 C.F.R. § 1.78(a)(2), which is applicable to the subject application.

The subject application was abandoned on October 7, 2001, in favor of Continuation Application No. 09/972,473, filed on October 4, 2001.

Recently, the file of pending Continuation Application No. 09/972,473 and its priority applications, including the subject application, were transferred to this firm. As a result of a review of these files, the undersigned became aware that the subject application had not been amended to supply the relationships of the priority applications. Accordingly, the Amendment filed concurrently herewith directs amendment of the specification of the subject application to contain a "Cross-Reference to Related Applications" paragraph that contains specific reference to the priority applications, including the relationships of the priority applications, as required by former 35 U.S.C. § 120 and former 37 C.F.R. § 1.78(a)(2), which are applicable to the subject application.

This petition can and should be granted because, as stated by the court in Sampson, "[a] reading of [35 U.S.C.] § 120 makes it clear that an amendment may be entered in an abandoned

application for purposes other than prosecution.” Sampson v. Commissioner of Patents and Trademarks, 195 USPQ 136, 137 (D.D.C. 1976) (Authorizing amendment of the related applications paragraph of an abandoned intermediate application to perfect a priority claim in a reissue application).

Entry of the concurrently filed Amendment is respectfully requested in order to perfect the specific reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2) in the subject application, and to permit Applicant to claim priority in pending Continuation Application No. 09/972,473 through the subject application. The PTO is also requested to issue a Corrected Filing Receipt showing the relationships of the priority applications.

In accordance with 37 C.F.R. § 1.182, a check in the amount of \$130.00 in payment of the petition fee under 37 C.F.R. § 1.17(h) is enclosed herewith.

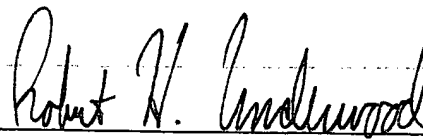
To the extent that it may be necessary, please consider this paper as a Petition under either 37 C.F.R. § 1.183. Authorization to charge any deficiency or credit any overpayment in the fees that may be due in this matter, including any fees under 37 C.F.R. § 1.17(h), to Deposit Account Number 08-0380 is hereby granted. A copy of this letter is enclosed for accounting purposes.

The Patent Office is invited to contact the undersigned if they feel that a telephone conference would expedite resolution of this matter.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

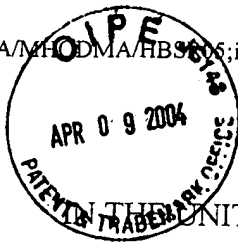
By



Robert H. Underwood
Registration No. 45,170
Telephone: (978) 341-0036
Facsimile: (978) 341-0136

Concord, MA 01742-9133

Dated: February 27, 2004



COPY

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Sean A. McCarthy

Application No.: 09/263,022 (ABANDONED) Group: 1647

Filed: March 5, 1999 Examiner: David S. Romeo

Confirmation No.: 1313

For: NOVEL HUMAN DICKKOPF-RELATED PROTEIN AND NUCLEIC
ACID MOLECULES AND USES THEREFOR

Date: <u>February 27, 2004</u>
EXPRESS MAIL LABEL NO. <u>EL 955641153 US</u>

AMENDMENT

VIA EXPRESS MAIL LABEL NO. EL 955641153 US

Mail Stop PETITION

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Please amend the application as follows:

Amendments to the Specification

Please replace the Cross-Reference to Related Applications paragraph at page 1, lines 5 through 14 with the following amended paragraph:

The present application ~~claims the benefit of prior-filed application~~ is a continuation-in-part of PCT Application No. PCT/US98/07894, filed April 16, 1998, designating the United States, which in turn claims the benefit of prior-filed application is a continuation-in-part of U.S. Patent Application Serial No. 09/009,802, filed January 20, 1998[[.]] ~~U.S. Patent Application Serial No. 09/009,802, which claims the benefit of prior-filed U.S. Patent Application Serial No. 60/071,589, filed January 15, 1998 and of prior-filed~~ which is a continuation-in-part of U.S. Patent Application Serial No. 08/842,898, filed April 17, 1997[[.]] ~~U.S. Patent Application Serial No. 08/842,898, which~~ is a continuation-in-part of U.S. Patent Application No. 08/843,704, filed April 16, 1997. The contents of each of the above-referenced patent applications are incorporated herein by this reference in their entirety.

REMARKS

The subject application included a Related Applications paragraph as filed. The present Amendment is being filed to include the relationships between certain applications referenced in the Related Applications paragraph, in order to perfect the specific reference required by 35 U.S.C. § 120 and 37 C.F.R. § 1.78(a)(2). In particular, relationships with International Application No. PCT/US98/07894, U.S. Patent Application No. 09/009,802, and U.S. Patent Application No. 08/842,898 have been added.

A "Petition Under 37 C.F.R. § 1.182 or § 1.183 Requesting Entry of Amendment" and fee are being filed concurrently. Entry of this Amendment is requested.

Respectfully submitted,

HAMILTON, BROOK, SMITH & REYNOLDS, P.C.

By Robert H. Underwood
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Registration No. 45,170
Telephone: (978) 341-0036
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Concord, MA 01742-9133

Dated: *February 27, 2004*